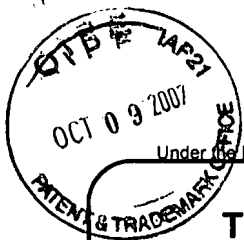


10-10-07

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PTO/SB/21 (10-07)

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Application Number	10/663,498
Filing Date	09-16-2003
First Named Inventor	Anderson
Art Unit	3611
Examiner Name	Silbermann
Attorney Docket Number	453.1

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/663,498  
Applicant / Appellant : **Anderson, James Scott**  
Filing Date : **September 16, 2003**  
Title : **ERASABLE TRAY LABELS**  
Art Unit : 3611  
Examiner : **Silbermann, Joanne**  
Confirmation No. : 2443  
Docket No. : 453.1

Mail Stop Appeal Brief – Patents  
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Post Office Box 1450  
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**REPLY BRIEF**

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Pursuant to MPEP 1208 and 37 C.F.R. § 41.41(a), the Applicant/Appellant hereby submits this Reply Brief in response to the Examiner's Answer dated August 7, 2007.

The Examiner's final rejection must be reversed because the cited references do no teach or suggest all the elements of the claimed invention. First, the "writing surface" recited in claims 1 and 16 cannot be obvious in light of a single reference disclosing no writing surface whatsoever. Second, the "semi-rigid core [with] a slot" recited in claims 34 and 43 cannot be obvious in light of the hollow space inside a plastic medallion. Because the references do not teach or suggest all the features recited in the claims, the rejection fails to set forth a *prima facie* case of obviousness and the rejection should be reversed, with instructions to allow all the pending claims in the application.

**I. THE “WRITING SURFACE” RECITED IN CLAIMS 1 AND 16  
CANNOT BE OBVIOUS IN LIGHT OF A SINGLE REFERENCE  
DISCLOSING NO WRITING SURFACE WHATSOEVER.**

A single reference<sup>1</sup> that does not teach or suggest a “writing surface” as claimed does not satisfy the examiner’s initial burden of establishing a *prima facie* case of obviousness. Downing does not teach or suggest a writing surface of any kind.

The rejection of independent claims 1 and 16 rests entirely on the Examiner’s assertion that the disclosure in a single reference of an apparatus having *any surface* with indicia thereon (*e.g.*, Downing) teaches or suggests a “writing surface” as recited in claims 1 and 16.<sup>2</sup> Applying basic logic, the disclosure of an apparatus having *any surface* cannot render obvious the pending claims reciting “a generally planar writing surface for receiving temporary and permanent indicia” and other patentable features.

The surface in Downing should not be considered a writing surface simply because it includes permanent indicia. Many surfaces include permanent indicia, from computer keyboards to telephones and automobiles. The presence of permanent indicia does not make every such surface a “writing surface” – *especially the surface in Downing*. Downing discloses a detachable cushion for the armrest of a chair – plainly not a suitable location for writing temporary indicia because it would be quickly smudged or erased during normal use. No person reading Downing would conclude that a cushion on the armrest of a chair is a writing surface.

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<sup>1</sup> *Downing* is not combined with any other reference to support the rejection.

<sup>2</sup> For easy reference, claims 1 and 16 are set forth in Appendix One.

The “writing surface” recited in claims 1 and 16 cannot be considered obvious by the disclosure in Downing of a surface that is plainly not a writing surface. The claims do not recite *any surface* or *any surface with indicia*. The claims recite a “writing surface” *etc.* – which is not taught or suggested by Downing.

The obviousness rejection of these claims, citing no reference that teaches or suggests a writing surface, simply does not meet the fundamental requirement that the reference(s) teach or suggest all the elements of the claimed invention, and it should be reversed.

**II. THE “SEMI-RIGID CORE [WITH] A SLOT” AS RECITED IN  
CLAIMS 34 AND 43 CANNOT BE OBVIOUS IN LIGHT OF THE  
HOLLOW SPACE INSIDE A PLASTIC MEDALLION.**

Neither Weller nor Schmeida teach or suggest a semi-rigid core, as recited in independent claims 34 and 43<sup>3</sup>. Weller discloses a hollow, plastic medallion having no core element. (Weller, at col. 4, lines 16-24). Schmeida discloses an adhesive label, (col. 4, lines 62-65,) also having no core element.

The “core 10” in Weller is a hollow space – not a physical element. A hollow space cannot render obvious the “semi-rigid core” recited in claims 34 and 43. The Examiner’s assertion that “Weller teaches core 10” is misleading (at best) and should carry no weight. The disclosure of a hollow space cannot reasonably satisfy the

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<sup>3</sup> For easy reference, claims 34 and 43 are set forth in Appendix Two.

examiner's initial burden of setting forth a *prima facie* case of obviousness with respect to the "semi-rigid core" as recited in claims 34 and 43.

The obviousness rejection of these claims simply does not meet the fundamental requirement that the references teach or suggest all the elements of the claimed invention. Accordingly, the rejection should be reversed.

### III. CONCLUSION

Because the references do not teach or suggest all the elements of the claimed invention, and because the rejection fails to state a *prima facie* case of obviousness, the rejection should be reversed, with instructions to allow all the pending claims in the application.

Respectfully submitted,



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J. Scott Anderson

## **APPENDIX ONE**

### **Independent Claims 1 and 16**

1. A label assembly comprising:
  - a generally planar writing surface for receiving temporary and permanent indicia; and
  - a semi-rigid core supporting said writing surface, said core defining a slot positioned and sized to releasably receive an edge of a generally planar wall of an open container such that a majority of said writing surface extends beyond said edge when said edge is received within said slot, and wherein the orientation of said slot is generally parallel to said writing surface.
16. A method of releasably mounting an erasable label across an edge of a generally planar wall of an open container, said method comprising:
  - providing a generally planar writing surface to receive said label, said writing surface suitable for receiving temporary and permanent indicia;
  - mounting said writing surface to a semi-rigid core; and
  - forming a slot within said core, said slot positioned and sized to releasably receive said edge such that a majority of said writing surface extends beyond said edge when said edge is received within said slot, and wherein the orientation of said slot is generally parallel to said writing surface.

## **APPENDIX TWO**

### **Independent Claims 34 and 43**

34. A label assembly comprising:

a generally planar writing surface for receiving temporary and permanent indicia; and

a semi-rigid core supporting said writing surface, said core having a thickness and generally opposing top and bottom sides, said writing surface extending from near said top side to a lower boundary,

wherein said core defines a slot within said thickness, said slot extending upward from said bottom side to a depth terminating near said lower boundary of said writing surface such that a majority of said writing surface extends beyond and generally above said slot.

43. A method of assembling a label, comprising:

providing a generally planar writing surface suitable for receiving temporary and permanent indicia;

mounting said writing surface to a semi-rigid core, said core having a thickness and generally opposing top and bottom sides, such that said writing surface extends from near said top side to a lower boundary; and

forming a slot within said thickness, said slot extending upward from said bottom side to a depth terminating near said lower boundary of said writing surface such that a majority of said writing surface extends beyond and generally above said slot.